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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,106	04/13/2001	Dan A. Steinberg	ACT.008	4209

110 7590 03/18/2004

DANN, DORFMAN, HERRELL & SKILLMAN
1601 MARKET STREET
SUITE 2400
PHILADELPHIA, PA 19103-2307

EXAMINER

ZARROLI, MICHAEL C

ART UNIT	PAPER NUMBER
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2839

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,106

Applicant(s)

STEINBERG ET AL.

Examiner

Michael C. Zarroli

Art Unit

2839

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6 and 8-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,5,6,8-27 and 34 is/are allowed.
- 6) ☒ Claim(s) 28,31,35,37,39,42 and 43 is/are rejected.
- 7) ☒ Claim(s) 29,30,32,33,36,38,40 and 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>numerous</u> . | 6) <input type="checkbox"/> Other: _____ |

1. **New grounds of rejection have necessitated this first action nonfinal after filing of an RCE.**

Claim Objections

2. Claim 29 objected to because of the following informalities: Misspelling of An. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 28 and 31 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shigematsu et al (US 5185825).

Shigematsu discloses an optical switch (title), comprising: a substrate (41) having at least one longitudinal groove and at least one transverse groove (unnumbered figures 3a & 3b); a first waveguide holding member (21) having at least one transverse groove (23); and a second waveguide holding member (22) having at least one longitudinal groove (34).

Regarding claim 31 Shigematsu discloses that said substrate further includes at least one pit (figures 3a & 3b unnumbered).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 35, 37, 39 and, 42-43 rejected under 35 U.S.C. 103(a) as being unpatentable over You et al (US 6160936).

You discloses a first waveguide holding member (110) and a second waveguide holding member (120) disposed over a substrate (100), said first waveguide holding member being movable relative to said substrate; and at least one movement guiding member (fig. 1) disposed between said substrate and said first waveguide holding member to guide the motion of said first waveguide holding member relative to said second waveguide holding member (claim 1 lines 50-53), said movement guiding member comprising at least one depression (124) and at least one positioning member (102) disposed in said depression.

You does not disclose that this structure is intended for use as an optical switch.

However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

Ex parte Masham, 2 USPQ2d 1647 (1987).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to employ the optical waveguide aligner/connector of You et al as an optical switch. The motivation/suggestion for doing so would have been utilize the invention of You et al as an on/off switch; alignment of the first and second waveguide transmits an optical signal and then a loss of signal when the first waveguide is slid out of focus from the second waveguide.

In addition, the examiner calls attention to MPEP 2111.02. Where the discussion is that a preamble is generally not accorded any patentable weight where it merely recites the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone. In re Hiro, 535 F. 2d 67, 190 USPQ 15 (CCPA 1976), Kropa v. Robie, 88 USPQ 478, 481 (CCPA 1951).

Regarding claim 37 You discloses that said movement guiding member is configured to permit said first waveguide holding member to move longitudinally relative to said second waveguide holding member (fig. 1).

Regarding claim 39 You discloses that the at least one is disposed in said first waveguide holding member (112 or 124 in fig. 1).

Regarding claim 42 You does not disclose that the substrate and at least one of the waveguide holding members are comprised of a monocrystalline material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form these components out of a monocrystalline material, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S.164. The motivation for this material would be its noted strength characteristics.

Regarding claim 43 You discloses (fig. 1) that at least one movement guiding member disposed between said substrate and said second waveguide holding member to guide the motion of said second waveguide holding member relative to said first waveguide holding member, said movement guiding member comprising at least one depression (120) and at least one positioning member (102) disposed therein.

Allowable Subject Matter

7. Claims 1-3, 5-6, 8-27 and, 34 allowed.

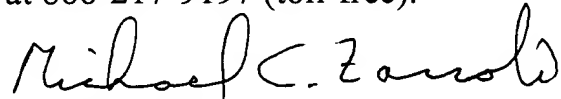
8. Claims 29-30, 32-33, 36, 38 and, 40-41 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. Reasons for allowance were given in previous office actions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Zarroli whose telephone number is 571-272-2101. The examiner can normally be reached on 7:30 to 3:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Feild can be reached on (571) 272-2800 ext 39. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael C. Zarroli
Primary Examiner
Art Unit 2839

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